

Amendment and Response Under 37 C.F.R. 1.116

Applicant: Scott E. Jahns et al.

Serial No.: 10/763,861

Filed: January 22, 2004

Docket No.: M190.113.101/P-9198.00

Title: VESSEL SEALING DEVICES

REMARKS

The following remarks are made in response to the Final Office Action mailed August 22, 2007. Claims 1-18, 20-29, and 48-57 were rejected. With this Response, claims 1, 21, and 48 have been amended. Claims 1-18, 20-29, and 48-57 remain pending in the application and are presented for reconsideration and allowance.

Oath/Declaration

The Office Action asserts the declaration was defective and should be in compliance with 37 C.F.R. 1.67(a) identifying this application by application number and filing date. Applicants respectfully submit that the submitted Declaration is in compliance with 37 C.F.R. 1.63, as defined in 37 C.F.R. 1.56. *See*, 37 C.F.R. 1.63(b)(3) (2004) (“the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.”) For example, the submitted Declaration states the inventors “acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56(a).”

This quoted phrase was in wide use prior to the amendments to 37 C.F.R. 1.63(b), and it still complies with the regulations at present. The USPTO specified and permitted wide use of this quoted phrase prior to the 1992 amendment of 37 C.F.R. 1.63(b). This quoted phrase was specified as acceptable prior to the amendment.

Further, this phrase continues to be in effect by the USPTO’s own pronouncement. The USPTO explicitly stated that the pre-1992 oaths comply with the now used language and would continue to be accepted by the USPTO. In its affirmation, the USPTO stated in the Federal Register that “The averments in oath or declaration forms presently in use that comply with the previous [37 C.F.R.] 1.63 or 1.175 will also comply with the requirements of the new rules. Therefore, the Office will continue to accept the old oath or declaration forms as complying with the new rules.” 57 Fed. Reg. 2034 (Jan. 17, 1992).

Accordingly, Applicants respectfully request entry of the submitted Declaration and removal of the objection that the submitted Declaration is defective.

Claim Rejections under 35 U.S.C. § 103

The pending claims 1-18, 20-29, and 48-57 were rejected under 35 U.S.C. 103(a). Claims 1, 21, and 48 are independent claims. Claims 2-18 and 20 depend from claim 1. Claims 22-29 depend from claim 21. And claims 49-57 depend from claim 48. With this amendment, the independent claims are amended.

Rejection of Claims 1-18 and 20 under 35 U.S.C. 103(a)

Claims 1-18 and 20 were rejected under 35 U.S.C. 103(a). Of these claims, claim 1 is independent and the remaining claims depend from claim 1. With this response, claim 1 is amended.

Claim 1-7, 9, and 11-14

Claims 1-7, 9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole US Patent No. 5,893,369 in view of Nobles et al. US Patent No. 6,171,319 in further view of Burbank et al. US Patent No. 6,689,071. With this response, claim 1 has been amended to include the features of “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body . . . and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.”

This feature is neither shown nor made obvious in the prior art of record. In the case of each of the references, there is no corresponding feature of a “cutting mechanism . . . stationary with respect to the tool body” as set forth in amended claim 1. LeMole, Nobles, and Burbank show the cutting mechanism is moveable with respect to the tool body. LeMole shows the cutting mechanism fixedly coupled to the seal and moveable with respect to the tool body. Nobles shows that each of the cutting mechanism and the seal independently moveable with respect to each other and to the tool body. Burbank shows a cutting device moveable with respect to the tool body.

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Further, there is no corresponding feature of “wherein the seal is moveable distally and proximally with respect to the cutting mechanism” as set forth in the amended claim. LeMole and Nobles show the cutting mechanism is always proximal to the seal. The device of LeMole shows a cutting mechanism trailing the seal as the seal is advanced into the blood vessel. The device of Nobles shows that the cutting mechanism and the seal are independently moveable with respect to each other except the cutting mechanism is always proximal to the seal. Burbank does not teach a seal with respect to the cutting mechanism.

There is also nothing in the prior art to make obvious the amended features. LeMole and Nobles indicate the prior art method of passing a seal through first, and then making an opening. Burbank does not recognize the use of a seal or the use of a cutting mechanism attached to the tool body. The prior art does not make obvious a device or method that can cut a blood vessel first and then passes a seal through the opening because in each case the seal is too wide to fit within the tool body or the tool body is too wide to accept the seal and still make a properly sized opening in the blood vessel. Therefore, the prior art does not teach a device that makes obvious the amended features of claim 1 as set forth above.

As demonstrated, the amended features of claim 1 are neither shown in LeMole, Nobles, or Burbank nor are they made obvious in the prior art. Because the amended features are not shown or made obvious in each of the references separately, they cannot be found in any proposed combination of the references. Accordingly, Applicants respectfully submit that claim 1 is patentably distinguishable from the prior art of record.

Further, claims 2-7, 9, and 11-14 depend from claim 1. By virtue of their dependency, these claims are also patentably distinguishable from the combination of LeMole, Nobles, and Burbank.

Accordingly, Applicants submit that claim 1-7, 9, and 11-14 are patentably distinguishable from the prior art and respectfully request removal of the rejection and for allowance of the claims.

Claims 8, 10, 18, and 20

Claims 8, 10, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole US Patent No. 5,893,369 in view of Nobles US Patent No. 6,171,319 and Burbank US Patent No. 6,689,071, as applied to claim 1, in further view of Fortune US Publication No. 2004/0215231. Claims 8, 10, 18, and 20 depend from independent claim 1, which has been shown above to be patentable over the combination of LeMole, Nobles, and Burbank. Applicants submit that claims 8, 10, 18, and 20 are patentably distinguishable from this combination in further view of Fortune.

As discussed above with respect to claim 1, LeMole, Nobles, and Burbank do not teach the amended features of “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body . . . and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.” Applicants submit that Fortune also does not teach or make obvious the amended features.

Fortune discloses a particular type of seal device that can be used instead of the seal devices of LeMole or Nobles. Fortune does not teach a cutting mechanism used in combination with its seal device. Accordingly, it cannot teach the amended features. Also, Fortune presumes the use of conventional cutting mechanisms to form an opening in the blood vessel prior to placement of its seal. One skilled in the art would not be inclined to use the teachings of Fortune to solve the problem facing Applicants.

Because the amended features are missing from LeMole, Nobles, Burbank, and Fortune in the combination, the amended features cannot be found in any proposed combination of the references. Applicants respectfully submit that claims 8, 10, 18, and 20 are patentably distinguishable from the combination of references. Applicants also respectfully request removal of the rejection and for allowance of claims 8, 10, 18, and 20.

Claims 15-17

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole US Patent No. 5,893,369 in view of Nobles et al. US Patent No. 6,171,319 and Burbank US Patent No. 6,689,071, as applied to claim 1, in further view of Blatter US Patent No. 6,248,117. Claims

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15-17 depend from independent claim 1, which has been shown above to be patentable over the combination of LeMole, Nobles, and Burbank. Applicants submit that claims 15-17 are patentably distinguishable from this combination in further view of Blatter.

As discussed above with respect to claim 1, LeMole, Nobles, and Burbank do not teach the amended features of “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body . . . and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.” Applicants submit that Blatter also does not teach or make obvious the amended features.

Blatter discloses an opening in an anvil device 160, which is attached to the piercing wire. Applicants submit that the anvil device is not a seal as set forth in the amended claims in that it acts in combination with a catheter. To the extent, however, that this anvil device is analogous to the seal, the apparatus of Blatter still does not meet the terms of the amended features. For example, the apparatus of Blatter pokes a hole in the blood vessel with a piercing wire attached to the anvil. The piercing wire is movable with respect to the tool body. Accordingly, Blatter does not meet the terms of the amended features set forth in claim 1, and thus does not teach the features of the amended claim.

Further, Blatter does not make obvious a modification to teach the amended features. Blatter is more analogous to Burbank in the “cutting mechanism” is not “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body.” One skilled in the art would not be inclined to use the teachings of Blatter to solve the problem facing Applicants.

Because the amended features are missing from every reference in the combination of LeMole, Nobles, Burbank, and Blatter, the amended features cannot be found in any proposed combination of the references. Applicants respectfully submit that claims 15-17 are patentably distinguishable from the combination of references. Applicants also respectfully request removal of the rejection and for allowance of claims 15-17.

Rejection of Claims 21-29 under 35 U.S.C. 103(a)

Claims 21-29 were rejected under 35 U.S.C. 103(a). Of these claims, claim 21 is independent and the remaining claims depend from claim 21. With this response, claim 21 is amended.

Claims 21, 22, 24, and 26

Claims 21, 22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole US Patent No. 5,893,369 in view of Nobles et al. US Patent No. 6,171,319. With this response, independent claim 21 has been amended to include the features of “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body . . . and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.”

This feature is neither shown nor made obvious in the prior art of record. In the case of each of the references, there is no corresponding feature of a “cutting mechanism . . . stationary with respect to the tool body” as set forth in amended claim 21. LeMole and Nobles show the cutting mechanism is moveable with respect to the tool body. LeMole shows the cutting mechanism fixedly coupled to the seal and moveable with respect to the tool body. Nobles shows that each of the cutting mechanism and the seal independently moveable with respect to each other and to the tool body.

Further, there is no corresponding feature of “wherein the seal is moveable distally and proximally with respect to the cutting mechanism” as set forth in the amended claim. LeMole and Nobles show the cutting mechanism is always proximal to the seal. The device of LeMole shows a cutting mechanism trailing the seal as the seal is advanced into the blood vessel. The device of Nobles shows that the cutting mechanism and the seal are independently moveable with respect to each other except the cutting mechanism is always proximal to the seal.

There is also nothing in the prior art to make obvious the amended features. LeMole and Nobles indicate the prior art method of passing a seal through first, and then making an opening. The prior art does not make obvious a device or method that can cut a blood vessel first and then passes a seal through the opening because in each case the seal is too wide to fit within the tool

body or the tool body is too wide to accept the seal and still make a properly sized opening in the blood vessel. Therefore, the prior art does not teach a device that makes obvious the amended features of claim 21 as set forth above.

As demonstrated, the amended features of claim 21 are neither shown in LeMole, or Nobles nor are they made obvious in the prior art. Because the amended features are not shown or made obvious in each of the references separately, they cannot be found in any proposed combination of the references. Accordingly, Applicants respectfully submit that claim 1 is patentably distinguishable from the prior art of record.

Further, claims 22, 24, and 26 depend from claim 21. By virtue of their dependency, these claims are also patentably distinguishable from the combination of LeMole and Nobles.

Accordingly, Applicants submit that claim 21, 22, 24, and 26 are patentably distinguishable from the prior art and respectfully request removal of the rejection and for allowance of the claims.

Claims 23 and 25

Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole US Patent No. 5,893,369 in view of Nobles US Patent No. 6,171,319, as applied to claim 21, in further view of Fortune US Publication No. 2004/0215231. Claims 23 and 25 depend from independent claim 21, which has been shown above to be patentable over the combination of LeMole and Nobles. Applicants submit that claims 23 and 25 are patentably distinguishable from this combination in further view of Fortune.

As discussed above with respect to claim 21, LeMole and Nobles do not teach the amended features of “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body . . . and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.” Applicants submit that Fortune also does not teach or make obvious the amended features.

Fortune discloses a particular type of seal device that can be used instead of the seal devices of LeMole or Nobles. Fortune does not teach a cutting mechanism used in combination with its seal device. Accordingly, it cannot teach the amended features. Also, Fortune presumes

the use of conventional cutting mechanisms to form an opening in the blood vessel prior to placement of its seal. One skilled in the art would not be inclined to use the teachings of Fortune to solve the problem facing Applicants.

Because the amended features are missing from LeMole, Nobles, and Fortune in the combination, the amended features cannot be found in any proposed combination of the references. Applicants respectfully submit that claims 23 and 25 are patentably distinguishable from the combination of references. Applicants also respectfully request removal of the rejection and for allowance of claims 23 and 25.

Claims 27-29

Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole US Patent No. 5,893,369 in view of Nobles US Patent No. 6,171,319, as applied to claim 21, in further view of Blatter US Patent No. 6,248,117. Claims 15-17 depend from independent claim 1, which has been shown above to be patentable over the combination of LeMole and Nobles. Applicants submit that claims 27-29 are patentably distinguishable from this combination in further view of Blatter.

As discussed above with respect to claim 1, LeMole and Nobles do not teach the amended features of “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body . . . and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.” Applicants submit that Blatter also does not teach or make obvious the amended features.

Blatter discloses an opening in an anvil device 160, which is attached to the piercing wire. Applicants submit that the anvil device is not a seal as set forth in the amended claims in that it acts in combination with a catheter. To the extent, however, that this anvil device is analogous to the seal, the apparatus of Blatter still does not meet the terms of the amended features. For example, the apparatus of Blatter pokes a hole in the blood vessel with a piercing wire attached to the anvil. The piercing wire is movable with respect to the tool body. Accordingly, Blatter does not meet the terms of the amended features set forth in claim 1, and thus does not teach the features of the amended claim.

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Further, Blatter does not make obvious a modification to teach the amended features. Also, the Blatter “cutting mechanism” is not “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body.” One skilled in the art would not be inclined to use the teachings of Blatter to solve the problem facing Applicants.

Because the amended features are missing from every reference in the combination of LeMole, Nobles, and Blatter, the amended features cannot be found in any proposed combination of the references. Applicants respectfully submit that claims 27-29 are patentably distinguishable from the combination of references. Applicants also respectfully request removal of the rejection and for allowance of claims 27-29.

Rejection of Claims 48-57 under 35 U.S.C. 103(a)

Claims 48-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole US Patent No. 5,893,369 in view of Nobles US Patent No. 6,171,319 and in further view of Fortune US Publication No. 2004/0215231. Within this group of claims, claims 49-57 depend from independent claim 48. With this response, claim 48 has been amended to include the features of “a tool body fixedly coupled to the cutting mechanism wherein the cutting mechanism is generally stationary with respect to the tool body . . . and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.”

This feature is neither shown nor made obvious in the prior art of record. In the case of each of the references, there is no corresponding feature of a “cutting mechanism . . . stationary with respect to the tool body” as set forth in amended claim 48. LeMole, Nobles, and Fortune show the cutting mechanism is moveable with respect to the tool body. LeMole shows the cutting mechanism fixedly coupled to the seal and moveable with respect to the tool body. Nobles shows that each of the cutting mechanism and the seal independently moveable with respect to each other and to the tool body. Fortune discloses a particular type of seal device that can be used instead of the seal devices of LeMole or Nobles. Fortune does not teach a cutting mechanism used in combination with its seal device.

There is also nothing in the prior art to make obvious the amended features. LeMole and Nobles indicate the prior art method of passing a seal through first, and then making an opening. Fortune presumes the use of conventional cutting mechanisms to form an opening in the blood vessel prior to placement of its seal. One skilled in the art would not be inclined to use the teachings of Fortune in combination with LeMole and Nobles to solve the problem facing Applicants. Therefore, the prior art does not teach a device that makes obvious the amended features of claim 48 as set forth above.

As demonstrated, the amended features of claim 48 are neither shown in LeMole, Nobles, or Fortune nor are they made obvious in the prior art. Because the amended features are not shown or made obvious in each of the references separately, they cannot be found in any proposed combination of the references. Accordingly, Applicants respectfully submit that claim 48 is patentably distinguishable from the prior art of record.

Further, claims 49-57 depend from claim 48. By virtue of their dependency, these claims are also patentably distinguishable from the combination of LeMole, Nobles, and Fortune.

Accordingly, Applicants submit that claim 49-57 are patentably distinguishable from the prior art and respectfully request removal of the rejection and for allowance of the claims.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-18, 20-29 and 48-57 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-18, 20-29 and 48-57 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to Rudolph P. Hofmann at Telephone No. (612) 573-2010, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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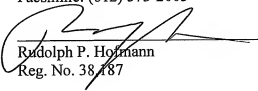
Respectfully submitted,

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